

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on

Atty Docket No.: NUFO 028  
U.S. Serial No. 09/848,914

Aug. 28, 2001  
Date Cindy K. Hoang  
Cindy K. Hoang



# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Chapman et al.

Group Art Unit: Unassigned

Serial No.: 09/848,914

Examiner: Unassigned

Filing Date: May 4, 2001

Title: METHOD AND APPARATUS FOR TUNING A LASER

PETITION UNDER 37 C.F.R § 1.47

The Commissioner of  
Patent and Trademarks  
Washington, D.C. 20231

**RECEIVED**

SEP 10 2001

OFFICE OF PETITIONS

Sir:

This is a petition to allow the assignee and owner of the entire interest of the above-referenced patent application to make an application for patent on behalf of and as agent for one co-inventor who refuses to execute a Declaration as an inventor under 37 CFR §1.63.

The above identified patent application was filed in the names of William Chapman, Timothy Day and John Pease, and Paul Zorabedian. New Focus, Inc. is the owner of the entire interest of the above-identified patent application. Declarations under 37 CFR §1.63 have been signed by co-inventors William Chapman, Timothy Day and John Pease. Assignments to New Focus by co-inventors William Chapman, Timothy Day and John Pease have been executed but have not yet been recorded.

The co-inventor Paul Zorabedian for the above-identified patent application was, at the time of invention, an employee of New Focus. Mr. Zorabedian subsequently left employment at New Focus prior to filing of the subject patent application. Mr. Zorabedian was and is under contractual obligation to assign all rights in the invention of the above-identified patent application to New Focus, and to provide reasonable assistance to New Focus in obtaining patents on inventions for which Mr. Zorabedian was an inventor at New Focus. A copy of Mr. Zorabedian's employment agreement with New Focus is attached hereto as Exhibit A.

Mr. Zorabedian has refused to review the above-identified patent application or to sign a Declaration as an inventor unless New Focus pays him \$100,000.00. New Focus is under no obligation to make such a payment to Mr. Zorabedian, and Mr. Zorabedian's demand for

\$100,000.00 is unreasonable. Mr. Zorabedian has stated that no action on the part of the petitioner, other than payment of \$100,000.00, can persuade Mr. Zorabedian to review the application or sign an inventor Declaration. The efforts to obtain Mr. Zorabedian's Declaration as an inventor are described in the Declarations by Joseph T. FitzGerald, Mary E. Kelly, attached hereto as Exhibits B and C.

The undersigned attorney has sent Mr. Zorabedian a letter via first class mail to remind Mr. Zorabedian of his contractual obligation to assist in obtaining a patent for the above-identified application, and to again request that he sign a Declaration as an inventor. A copy of this letter is attached hereto as Exhibit D.

In that no rights in the invention are owned by Mr. Zorabedian, granting this petition would not affect Mr. Zorabedian's rights in any way. Granting of this petition is necessary to preserve the rights of New Focus in the invention.

This petition is being filed together with a response to a Notice to File Missing Parts. The Commissioner is authorized to charge our Deposit Account No.18-0580 for any fees required in the Notice to File Missing Parts, the petition fee under 37 CFR § 1.17(h), and any other fees due.

Date: \_\_\_\_\_

08/28/01

Respectfully submitted,

By: \_\_\_\_\_



Robert C. Hall

Registration No. 39,209

BOZICEVIC FIELD & FRANCIS LLP  
200 Middlefield Road, Suite 200  
Menlo Park, CA 94250  
Telephone: (650) 327-3400  
Fax: (650) 327-3231



NEW FOCUS, INC.

PROPRIETARY INFORMATION AGREEMENT

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SEP 10 2001

OFFICE OF PETITIONS

As an employee of New Focus, Inc., its subsidiary or its affiliate (together, the "Company"), and in consideration of the compensation now and hereafter paid to me, I agree to the following:

1. Maintaining Confidential Information

a. Company Information. I agree at all times during the term of my employment and thereafter to hold in strictest confidence, and not to use, except for the benefit of the Company, or to disclose to any person, firm or corporation without written authorization of the Board of Directors of the Company, any trade secrets, confidential knowledge, data or other proprietary information relating to products, processes, know-how, designs, formulas, developmental or experimental work, computer programs, data bases, other original works of authorship, customer lists, business plans, financial information or other subject matter pertaining to any business of the Company or any of its clients, consultants or licensees.

b. Former Employer Information. I agree that I will not, during my employment with the Company, improperly use or disclose any proprietary information or trade secrets of my former or concurrent employers or companies, if any, and that I will not bring onto the premises of the Company any unpublished document or any property belonging to my former or concurrent employers or companies, if any, unless consented to in writing by said employers or companies.

c. Third Party Information. I recognize that the Company has received and in the future will receive from third parties their confidential or proprietary information subject to a duty on the Company's part to maintain the confidentiality of such information and to use it only for certain limited purposes. I agree that I owe the Company and such third parties, during the term of my employment and thereafter, a duty to hold all such confidential or proprietary information in the strictest confidence and not to disclose it to any person, firm or corporation (except as necessary in carrying out my work for the Company consistent with the Company's agreement with such third party) or to use it for the benefit of anyone other than for the Company or such third party (consistent with the Company's agreement with such third party) without the express written authorization of the Board of Directors of the Company.

2. Retaining and Assigning Inventions and Original Works

a. Inventions and Original Works Retained by Me. I have attached hereto, as Exhibit A, a list describing all inventions, original works of authorship, developments, improvements, and trade secrets which were made by me prior to my employment with the Company, which belong to me, which relate to the Company's proposed business and products, and which are not assigned to the Company; or, if no such list is attached, I represent that there are no such inventions.

b. Inventions and Original Works Assigned to the Company. I agree that I will promptly make full written disclosure to the Company, will hold in trust for the sole right and benefit of the Company, and will assign to the Company all my right, title, and interest in and to any and all inventions, original works of authorship, developments, improvements or trade secrets which I may solely or jointly conceive or develop or reduce to practice, or cause to be conceived or developed or reduced to practice, during the period of time I am in the employ of the Company. I recognize, however, that Section 2870 of the California Labor Code (as set forth in Exhibit B attached hereto) exempts from this provision any invention as to which I can prove the following:

- (i) It was developed entirely on my own time; and
- (ii) No equipment, supplies, facilities or trade secrets of the Company were used in its development; and
- (iii) It either
  - (aa) does not relate, at the time the invention was conceived or reduced to practice, to the Company's or to the Company's actual or demonstrably anticipated research and development; or
  - (bb) does not result from any work performed by me for the Company.

I acknowledge that all original works of authorship which are made by me (solely or jointly with others) within the scope of my employment and which are protectable by copyright are "works made for hire," as that term is defined in the United States Copyright Act (17 USCA, Section 101).

c. Maintenance of Records. I agree to keep and maintain adequate and current written records of all inventions and

original works of authorship made by me (solely or jointly with others) during the term of my employment with the Company. The records will be in the form of notes, sketches, drawings, and any other format that may be specified by the Company. The records will be available to and remain the sole property of the Company at all times.

d. Inventions Assigned to the United States. I agree to assign to the United States government all my right, title, and interest in and to any and all inventions, original works of authorship, developments, improvements or trade secrets whenever such full title is required to be in the United States by a contract between the Company and the United States or any of its agencies.

e. Obtaining Letters Patent and Copyright Registrations. I agree that my obligation to assist the Company to obtain United States or foreign letters patent and copyright registrations covering inventions and original works of authorship assigned hereunder to the Company shall continue beyond the termination of my employment, but the Company shall compensate me at a reasonable rate for time actually spent by me at the Company's request on such assistance. If the Company is unable because of my mental or physical incapacity or for any other reason to secure my signature to apply for or to pursue any application for any United States or foreign letters patent or copyright registrations covering inventions or original works of authorship assigned to the Company as above, then I hereby irrevocably designate and appoint the Company and its duly authorized officers and agents as my agent and attorney in fact, to act for and in my behalf and stead to execute and file any such applications and to do all other lawfully permitted acts to further the prosecution and issuance of letters patent or copyright registrations thereon with the same legal force and effect as if executed by me. I hereby waive and quitclaim to the Company any and all claims, of any nature whatsoever, which I now or may hereafter have for infringement of any patents or copyrights, resulting from any such application for letters patent or copyright registrations assigned hereunder to the Company.

f. Exception to Assignments. I understand that the provisions of this Agreement requiring assignment to the Company do not apply to any invention which qualifies fully under the provisions of Section 2870 of the California Labor Code, a copy of which is attached hereto as Exhibit B. I will advise the Company promptly in writing of any inventions, original works of authorship, developments, improvements or trade secrets that I believe meet the criteria in Subparagraphs 2b(i), (ii), and (iii) above; and I will at that time provide to the Company in writing all evidence necessary to substantiate that belief. I understand that the Company will keep in confidence and will not disclose to third

parties without my consent any confidential information disclosed in writing to the Company relating to inventions that qualify fully under the provisions of Section 2870 of the California Labor Code.

3. Conflicting Employment. I agree that, during the term of my employment with the Company, I will not engage in any other employment, occupation, consulting or other business activity directly related to the business in which the Company is now involved or becomes involved during the term of my employment, nor will I engage in any other activities that conflict with my obligations to the Company.

4. Returning Company Documents. I agree that, at the time of leaving the employ of the Company, I will deliver to the Company (and will not keep in my possession or deliver to anyone else) any and all devices, records, data, notes, reports, proposals, lists, correspondence, specifications, drawings, blueprints, sketches, materials, equipment, other documents or property, or reproductions of any aforementioned items belonging to the Company, its successors or assigns. In the event of the termination of my employment, I agree to sign and deliver the "Termination Certification" attached hereto as Exhibit C.

5. Representations. I agree to execute any proper oath or verify any proper document required to carry out the terms of this Agreement. I represent that my performance of all the terms of this Agreement will not breach any agreement to keep in confidence proprietary information acquired by me in confidence or in trust prior to my employment by the Company. I have not entered into, and I agree I will not enter into, any oral or written agreement in conflict herewith.

6. Soliciting Employees. I agree that for a period of one (1) year following the termination of my employment with the Company, I will not solicit or offer employment to any employee of the Company.

7. General Provisions

a. Governing Law. This Agreement will be governed by the laws of the State of California.

b. Entire Agreement. This Agreement sets forth the entire agreement and understanding between the Company and me relating to the subject matter herein and merges all prior discussions between us. No modification of or amendment to this Agreement, nor any waiver of any rights under this agreement, will be effective unless in writing signed by the party to be charged. Any subsequent change or changes in my duties, salary or compensation will not affect the validity or scope of this Agreement.

c. Severability. If one or more of the provisions in this Agreement are deemed void by law, then the remaining provisions will continue in full force and effect.

d. Successors and Assigns. This Agreement will be binding upon my heirs, executors, administrators and other legal representatives and will be for the benefit of the Company, its successors, and its assigns.

Date: 8-26-98

Paul Zorabedian  
Signature

Paul Zorabedian  
Name of Employee

Shargur  
Witness

EXHIBIT A

LIST OF PRIOR INVENTIONS  
AND ORIGINAL WORKS OF AUTHORSHIP



<u>Title</u>	<u>Date</u>	<u>Identifying Number or Brief Description</u>
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Name of Employee: \_\_\_\_\_



EXHIBIT B

CALIFORNIA LABOR CODE SECTION 2870

EMPLOYMENT AGREEMENTS; ASSIGNMENT OF RIGHTS

"(a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:

(1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer.

(2) Result from any work performed by the employee for the employer.

(b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable."

EXHIBIT C

NEW FOCUS, INC.

TERMINATION CERTIFICATION

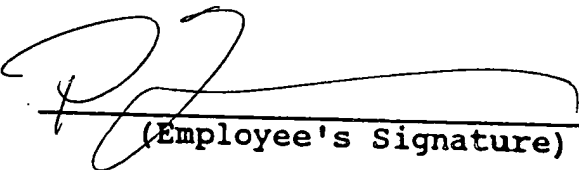
*Paul,  
Please sign  
& return*

This is to certify that I do not have in my possession, nor have I failed to return, any devices, records, data, notes, reports, proposals, lists, correspondence, specifications, drawings, blueprints, sketches, materials, equipment, other documents or property, or reproductions of any aforementioned items belonging to New Focus, Inc., its subsidiaries, affiliates, successors or assigns (together, the "Company").

I further certify that I have complied with all the terms of the Company's Employee Proprietary Information Agreement signed by me, including the reporting of any inventions and original works of authorship (as defined therein), conceived or made by me (solely or jointly with others) covered by that agreement.

I further agree that, in compliance with the Employee Proprietary Information Agreement, I will preserve as confidential all trade secrets, confidential knowledge, data or other proprietary information relating to products, processes, know-how, designs, formulas, developmental or experimental work, computer programs, data bases, other original works of authorship, customer lists, business plans, financial information or other subject matter pertaining to any business of the Company or any of its clients, consultants or licensees. Finally, I will not solicit or offer employment to any employee of the Company for a period of one year following the date of the termination of my employment.

Date: 5/5/00

  
(Employee's Signature)

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Assistant Commissioner for Patents, Washington, D.C. 20231 on

Atty Docket No. NUFO 028

Aug. 28, 2001  
Date

Cindy Huang  
by  
Cindy Huang  
Signature



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: Chapman et al.

Group Art Unit: Unassigned

Serial No.: 09/848,914

Examiner: Unassigned

Filing Date: May 4, 2001

Title: METHOD AND APPARATUS FOR TUNING A LASER

**DECLARATION BY JOSEPH T. FITZGERALD**

The Commissioner of  
Patent and Trademarks  
Washington, D.C. 20231

**RECEIVED**

SEP 10 2001

OFFICE OF PETITIONS

Sir:

I, Joseph T. FitzGerald, do hereby declare as follows:

I am an employee of New Focus Inc., the assignee and owner of all rights in the above-identified application. My title is Director of Intellectual Property, and my official place of business is located at 5215 Hellyer Avenue, San Jose California 95138-1001.

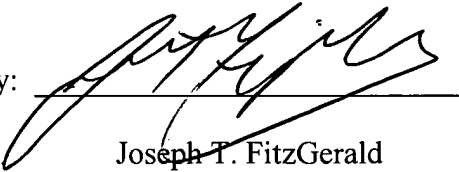
Paul Zorabedian is a co-inventor for the above-identified patent application and, at the time of invention, was an employee of New Focus. Mr. Zorabedian subsequently left employment at New Focus prior to filing of the subject patent application. Mr. Zorabedian was and is under contractual obligation to assign all rights in the invention of the above-identified patent application to New Focus, and to provide reasonable assistance to New Focus in obtaining patents on inventions for which Mr. Zorabedian was an inventor at New Focus. A copy of Mr. Zorabedian's employment agreement with New Focus is attached to the accompanying Petition under 37 CFR §1.47 as Exhibit A.

I was directly involved in the efforts to contact Mr. Zorabedian and obtain Mr. Zorabedian's Declaration (37 CFR §1.63) as an inventor. Prior to filing, efforts were made to contact Mr. Zorabedian via telephone and e-mail to request that Mr. Zorabedian review the patent application and sign an inventor Declaration. It was necessary to file the patent application by May 4, 2001 in order to preserve the benefit of a priority application. Mr. Zorabedian could not be contacted prior to May 4, 2001. The patent application was filed on May 4, 2001 without Mr. Zorabedian's Declaration as an inventor, in order to preserve the priority date.

On July 25, 2001, I participated in a telephone conversation with Mr. Zorabedian. Mary E. Kelly, the Intellectual Property Manager for New Focus, was present during the conversation. During the telephone conversation, I requested that Mr. Zorabedian review the patent application and sign a Declaration as inventor. Mr. Zorabedian responded by requesting payment of \$100,000.00, and informed me that he would not review the patent application or sign the Declaration until he received a check for \$100,000.00 from New Focus. New Focus is not under any obligation to make such a payment to Mr. Zorabedian. I replied to Mr. Zorabedian that payment of \$100,000.00 was unreasonable, and asked Mr. Zorabedian if there was any thing else that could be done to get Mr. Zorabedian to review the application and sign a Declaration. Mr. Zorabedian replied that there was not.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: Aug 28, 2001

By: 

Joseph T. FitzGerald

Director of Intellectual Property  
New Focus, Inc.  
5215 Hellyer Avenue  
San Jose, CA 95138-1001

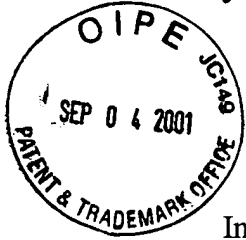
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Aug. 28, 2001  
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Cindy Hoang  
By

Cindy Hoang  
Signature



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: Chapman et al.

Group Art Unit: Unassigned

Serial No.: 09/848,914

Examiner: Unassigned

Filing Date: May 4, 2001

Title: METHOD AND APPARATUS FOR TUNING A LASER

**DECLARATION BY MARY E. KELLY**

The Commissioner of  
Patent and Trademarks  
Washington, D.C. 20231

**RECEIVED**

SEP 10 2001

**OFFICE OF PETITIONS**

Sir:

I, Mary E. Kelly, do hereby declare as follows:

I am an employee of New Focus, Inc., the assignee and owner of all right, title and interest in the above-identified application. My title is Intellectual Property Manager, and my official place of business is located at 5215 Hellyer Avenue, San Jose, California 95138-1001.

Paul Zorabedian is a co-inventor for the above-identified patent application and, at the time of invention, was an employee of New Focus. Mr. Zorabedian subsequently left employment at New Focus prior to filing of the subject patent application. Mr. Zorabedian was and is under contractual obligation to assign all rights in the invention of the above-identified patent application to New Focus, and to provide reasonable assistance to New Focus in obtaining patents on inventions for which Mr. Zorabedian was an inventor at New Focus. A copy of Mr. Zorabedian's employment agreement with New Focus is attached to the Petition under 37 CFR §1.47 as Exhibit A.

I was directly involved in the efforts to contact Mr. Zorabedian and obtain Mr. Zorabedian's Declaration (37 CFR §1.63) as an inventor. Prior to filing the application on May 4, 2001, efforts were made to contact Mr. Zorabedian via telephone and e-mail to

request that Mr. Zorabedian review the patent application and sign an inventor Declaration. It was necessary to file the patent application by May 4, 2001 in order to preserve the benefit of a priority application. Mr. Zorabedian could not be contacted prior to May 4, 2001. The patent application was filed on May 4, 2001 without Mr. Zorabedian's Declaration as an inventor, in order to preserve the priority date.

On July 25, 2001, I was present in the office of Joseph T. FitzGerald, the Director of Intellectual Property for New Focus, during a telephone conversation between Mr. FitzGerald and Mr. Zorabedian. During the telephone conversation Mr. FitzGerald requested that Mr. Zorabedian review the patent application and sign a Declaration as an inventor. Mr. FitzGerald, during the conversation, repeated Mr. Zorabedian's remark that he would not review the patent application or sign the Declaration until he received a check for \$100,000.00 from New Focus. New Focus is not under any obligation to make such a payment to Mr. Zorabedian. Mr. FitzGerald replied to Mr. Zorabedian that payment of \$100,000.00 was unreasonable, and asked Mr. Zorabedian if there was any thing else that could be done to get Mr. Zorabedian to review the application and sign a Declaration. Mr. FitzGerald repeated Mr. Zorabedian's response to me that nothing else could be done to induce Mr. Zorabedian to review the application and sign a Declaration other than payment of \$100,000.00.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: Aug. 28, 2001

By: Mary E. Kelly  
Mary E. Kelly

Intellectual Property Manager  
New Focus, Inc.  
5215 Hellyer Avenue  
San Jose, CA 95138-1001